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QUALCOMM INCORPORATED
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EXAMINER

JEANTY, ROMAIN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GIULIANO MACIOCCI and PAUL MABBUTT

Appeal 2016-001265
Application 13/216,044¹
Technology Center 3600

Before: HUNG H. BUI, SHARON FENICK, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

BENNETT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–58. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants' Brief ("App. Br.") identifies the real party in interest as Qualcomm, Inc.

CLAIMED SUBJECT MATTER

The claims are directed to an apparatus and method for representing a level of interest in an available item. Spec. ¶ 2. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method for representing a level of interest in an available item, the method comprising:
 - determining, by a computer, a release date for one or more applications;
 - calculating, by the computer, a level of interest for each of the one or more applications, wherein calculating the level of interest includes searching media for discussion of each of the one or more applications;
 - generating, by the computer, a user interface configured to illustrate the level of interest in each of the one or more applications based on the determined release date; and
 - providing, by the computer, the user interface to a mobile device.

App. Br. 13 (Claims Appendix).

REJECTION

Claims 1–58 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Final Act. 3.

The Examiner's Findings

In rejecting the claims, the Examiner finds the claims to be directed to “representing a level of interest in an available item,” and that “[r]epresenting a level of interest in an available item is a fundamental business practice” such that the claims are directed to an abstract idea. Final Act. 2. The Examiner further finds the limitations in the claims do not amount to “significantly more” in the abstract idea because “the claims do

not include an improvement to another technology or technical field, an improvement to the functioning of the computer itself, or meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment.” Final Act. 2–3. According to the Examiner, the limitations in the claims are performed by a generic computer processor, and the claim limitations are no more than mere instructions to implement the abstract idea on a generic computer using well-understood, routine, and conventional activities previously known. Final Act. 3. The Examiner explains the physical hardware upon which the claims are implemented amounts only to generic computer components and/or computer systems, and the claimed functions performed by these generic processing devices merely implement the abstract idea on the device or processor. Ans. 6.

In response to Appellants’ argument regarding *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014) (“*DDR Holdings*”),² the Examiner also finds the claims are not directed to a specific problem arising in technology. Ans. 6–7. The Examiner further finds the claims are merely directed to a generic processing device which performs recited functions, and that “the computer exercises routine computer functions for processing or effecting the abstract idea.” Ans. 7.

Appellants’ Contentions

Appellants present several arguments against the § 101 rejection. App. Br. 7–12; Reply Br. 2–4. Appellants first argue the claims on appeal should be afforded Streamlined Eligibility Analysis pursuant to the *2014 Interim*

² We discuss Appellants’ arguments regarding *DDR Holdings* in more detail below.

Guidance on Patent Subject Matter Eligibility. App. Br. 7. More specifically, Appellants argue that because the claims do not preempt the abstract idea of representing a level of interest in an available item, a full eligibility analysis was not needed to determine eligibility. App. Br. 7–8; Reply Br. 2.

Appellants further argue the claims amount to “something more” under the second step of the Alice/Mayo framework for several reasons. First, Appellants argue because they were successful in overcoming prior rejections under 35 U.S.C. §§ 102 and 103, demonstrates the claims are not merely well-understood, routine, and conventional activities previously known. App. Br. 9. Appellants further argue the Examiner’s “something more” analysis improperly reduces the functions performed by ignoring the data upon which the action is performed. According to Appellants, the Examiner has failed to consider the full extent of the claim language in independent claims 28 and 40–43 because the Examiner’s analysis does not acknowledge the object of the recited function of “receiving” recited in the claims. Reply Br. 2–3.

Appellants also argue the Federal Circuit’s decision in *DDR Holdings* requires reversal of the Examiner’s rejection. App. Br. 9–10. Appellants contend the acts of “searching media for discussion of each of the one or more applications” and generating a user interface “based on the determined release date” are functions which solve the technology-specific problem of how a level of interest in a product is going to be determined or calculated. App. Br. 10. According to Appellants, these actions are not routine or conventional operations, but instead provide “an enhancement to the operation of computer.” Reply Br. 3–4.

Appellants further contend the Examiner reneged on an agreement reached during an interview that the claims satisfy Part 2 of the Alice/Mayo framework, and the subsequent Advisory Action provided no explanation for the agreement not being honored. App. Br. 10–11.

ANALYSIS

We are not persuaded the Examiner has erred in rejecting Appellants’ claims. With respect to Appellants’ first argument that a streamlined eligibility analysis was warranted due to a lack of preemption, we note that the Guidance does not carry the force of law, *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 964 (Fed. Cir. 2002), and we must ensure we follow binding precedent in evaluating whether the Examiner erred in rejecting the claims as lacking patent-eligibility. Thus, even if the Examiner’s analysis is not consistent with the Guidance, that inconsistency is not of itself dispositive of Examiner error.

Our inquiry instead focuses instead on whether the Examiner has properly applied the two-step test set forth provided by the Supreme Court in *Alice Corp. Pty Ltd. v. CLS Bank Intl.*, 134 S. Ct. 2347 (2014). In analyzing patent-eligibility questions under 35 U.S.C. § 101, the Supreme Court instructs us to “first determine whether the claims at issue are directed to a patent-ineligible concept.” *Alice*, 134 S. Ct. at 2355. If the initial threshold is met, we then move to a second step and “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the by first claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 97). The Supreme Court describes the second step as a search for “an ‘inventive

concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.*

Aside from their assertions that a streamlined eligibility analysis was appropriate, Appellants do not explain or provide any evidence as to why the pending claims are not directed to an abstract idea as found by the Examiner.

Moreover, the Federal Circuit has made clear that lack of preemption does not, of itself, make claims non-abstract. *See buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (collecting cases); *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1345 (Fed. Cir. 2013); *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility”). Accordingly, we discern no error in the Examiner’s determination that the claims are directed to the abstract idea of representing a level of interest in an available item.

Appellants’ remaining arguments all focus on the second step of the *Alice/Mayo* framework as a search for “an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 134 S. Ct. at 2355. We address each in turn. With respect to Appellants’ first argument that the novelty and non-obviousness of the claims demonstrates the amount to “something more,” we do not find this argument persuasive. Appellants’ argument presupposes that any claim found to be novel and non-obviousness over prior art is necessarily an “inventive concept”, *i.e.*, “something more” in the *Alice/Mayo*

framework. We are aware of no case supporting this proposition, nor do Appellants cite to any. Nor would such a rule make sense, as it would limit the application of 35 U.S.C. § 101 to only those claims found to be otherwise unpatentable under other sections of the Patent Act (e.g., 35 U.S.C. §§ 102, 103, 112).

We are also not persuaded by Appellants' argument that the Examiner improperly characterized the claimed "receiving" functions by ignoring the nature of data that is received. The Federal Circuit has found similar limitations reciting "receiving" of specific data to be insufficient to transform an abstract idea into a patent-eligible concept. *See Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1345 (Fed. Cir. 2014) (finding limitation of "receiving output representing a diversity of types of hard copy documents from an automated digitizing unit and storing information from said diversity of types of hard copy documents into a memory, said information not fixed from one document to the next, said receiving step not preceded by scanning, via said automated digitizing unit, of a separate document containing format requirements" insufficient under Step 2); *see also In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 610 (Fed. Cir. 2016) (finding limitation of "receiving the data [including at least the digital images and classification information wherein said classification information is prescribable by a user of the telephone unit for allocation to the digital images] by the server" insufficient).

We also are not persuaded *DDR Holdings* mandates reversal here. Appellants argue *DDR Holdings* controls because the present claims involve functions which solve the technology-specific problem of how a level of

interest in a product is going to be determined or calculated, App. Br. 10, and that the functions are not routine or conventional operations, but instead provide “an enhancement to the operation of computer.” Reply Br. 3–4. We disagree.

We do not view determining the level of interest in a product as a problem unique to technology or the Internet. Nor do we view such determination constitutes “a specific improvement to the way computers operate” (*Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016)) or an “unconventional technological solution . . . to a technological problem” that “improve[s] the performance of the system itself” (*Amdocs (Israel) Ltd. v. Openet Telecom, Inc.* 841 F.3d 1288 (Fed. Cir. 2016)). Appellants’ Specification characterizes an “available item” as including “one or more of a content item, content, a service item, a service, or an electronic representation of least one of a content item, a service item, or a service.” Spec. ¶ 30. The Specification further states a content item includes, inter alia, “music, a movie . . . or any other type of media or information that may be rendered, processed, or executed on a device” Spec. 30. Thus, Appellants’ claims are directed to determining the level of interest in items such as music or movies. We see little difference between Appellants’ invention and determining the level of interest in a movie by taking a trip to the local library to see how many newspaper and magazine articles have been written about a particular movie prior to its release. The fact that Appellants’ invention is implemented in the context of the Internet does not mean that it solves a problem unique to the Internet. Accordingly, we are not persuaded the holding in *DDR Holdings* requires reversal.

Appellants further contend the Examiner reneged on an agreement reached during an interview that the claims satisfy the second step of the *Alice/Mayo* framework, and the subsequent Advisory Action provided no explanation for the agreement not being honored. Although not clear whether this argument is presented as a reason for reversing the rejection, we note the actions of the Examiner during prosecution are not reviewable on Appeal by the Board, but only by petition to the Director. *See, e.g.*, 37 C.F.R. § 41.31(c), § 1.181(a)(1).

In sum, we conclude the Examiner correctly determined that the pending claims are directed to an abstract idea. We further conclude Appellants' claims do not contain an "inventive concept" and that limitations recited in those claims amount to only routine steps of data collection, organization, and transmission using generic computer components and conventional computer data processing activities insufficient to transform the claim into "something more" than the abstract idea of itself. *See Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1341 (Fed. Cir. 2017). Accordingly, we are not persuaded the Examiner erred in finding the claims ineligible for patenting under 35 U.S.C. § 101, and we sustain the Examiner's § 101 rejection.

DECISION

The Examiner's § 101 rejection of claims 1–58 is affirmed. No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED